UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,088	03/25/2004	Alexander Torone	5486-0125PUS1	7665

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EXAMINER
MEMULA, SURESH

ART UNIT	PAPER NUMBER
2825	

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04/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *05 January 2009 and 12 March 2009*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-17* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *25 March 2004* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *3/12/2009*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This office action is a response to the RCE filed on 01/05/2009. Claims 1-17 are pending.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle,* 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submissions filed on 01/05/2009 and 3/12/2009 has been entered.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   **Claims 1-12 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. A patent eligible process under § 101 **must** (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

4.   Specifically, claim 1 recites a series of method steps directed to designing a system; however, the method step(s):

      (a)   are not tied to a particular apparatus utilized to perform step(s) of the method, or, for that matter, tied to any "another" statutory class, and

      (b)   do not positively recite the subject matter that is being transformed as a result of performing the prescriptive steps recited in claim 1.

5.   Therefore, since method claim 1 fails to meet either of the above two requirements, claims 1-12 do not qualify as a statutory process.

6.   This rejection is based on and supported by: MPEP § 2106.IV.B; *Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88
(1876).

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

8.   **Claims 1-17 are rejected under 35 U.S.C. 102(e)** as being anticipated by US
Pub. No. 2005/0102383 to Sutler (Hereinafter: Sutler).

9.   As to claim 1 and similarly recited claims 13,

modeling a particular hosting environment settings for the particular hosting
environment (¶9-12) including

configuring hosting environment settings for the particular hosting
environment (¶7, 30, 45, 47, 86, 88), and

identifying one or more device-specific constraints that are imposed by
the hosting environment settings on prospective applications to be hosted on the
particular hosting environment (¶7, 9-11, 30);

modeling a particular application (¶9-12) including

configuring application settings for the particular application (¶28, 30, 45,
47, 86, 88), and

identifying constraints imposed by the application settings on a
prospective hosting environment of the particular application (¶9, 28, 30, 33); and

validating the design of the system (¶9-11) by

comparing the hosting environment settings to the constraints imposed by
the application settings (¶9-11, 30), and

comparing the application settings to the device specific constraints imposed by the hosting environment settings (¶9-11, 30).

10.   As to claim 2, wherein the constraints imposed by the application settings or the hosting environment settings include configuration parameters (¶86, 88).

11.   As to claim 3, analyzing the application settings to determine whether the application settings satisfy the constraints imposed by the hosting environment settings (¶9-11, 30, 45).

12.   As to claim 4, analyzing the hosting environment settings to determine whether the hosting environment settings satisfy the constraints imposed by the application settings (¶9-11, 30, 45).

13.   As to claim 5 and similarly recited claim 16, wherein the particular hosting environment comprises a distributed computing system (¶9-11, 28).

14.   As to claim 6, wherein the particular hosting environment comprises a plurality of server computers (¶28).

15.   As to claim 7, wherein the particular hosting environment comprises a logical computer workstation (¶9-11, 28).

16.   As to claim 8, displaying on a display device a list of constraint conditions that are not satisfied (¶47, 56-57, 70, 86-89).

17.   As to claim 9, displaying a link in the list of constraint conditions that are not satisfied that links a condition in the list to a diagram that illustrates the condition (¶47, 56-57, 70, 86-89).

18.   As to claim 10, displaying on a display device an error icon when a constraint is not satisfied (¶47, 56-57, 70, 86-89).

19.   As to claim 11, wherein (a) comprises creating a system definition model document (¶45, 88).

20.   As to claim 12, wherein (b) comprises creating a system definition model document (¶45, 88).

21.   As to claim 14, wherein the validation module determines instances where the application settings do not satisfy the device-specific constraints imposed by the hosting environment settings (¶47, 56-57, 70, 86-89).

22.   As to claim 15, wherein the validation module determines instances where the hosting environment settings do not satisfy the constraints imposed by the application settings (¶47, 56-57, 70, 86-89).

23.   As to claim 17,

        displaying application elements (¶45, 47) in a first region of a user interface screen (FIG. 7-9, 11);

        displaying hosting environment elements (¶45, 47) in a second region of the user interface screen (FIG. 7-9, 11), at least one of the hosting environment elements representing a device in the hosting environment (¶7, 9-11, 28);

        in response to a command from a user moving elements from the first region to locations in the second region to bind application elements to hosting environment elements (¶47, 57-59, 73, 87-88);

        receiving via a design tool a user-designated hosting environment constraint imposed on the application (¶7, 9-11, 30) or a user-designated application constraint imposed on the hosting environment (¶9, 28, 30, 33);

        using the design tool to validate the design by analyzing application and hosting environment settings (¶9-11, 30) to determine whether the settings satisfy hosting environment and application constraints, respectively, including the user-designated constraint (¶9-11, 30); and

        displaying validation errors in a third region of the user interface screen (¶47, 56-57, 70, 86-89).

Conclusion

24.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to SURESH MEMULA whose telephone number is (571)272-8046. The examiner can normally be reached on Monday-Thursday 8:00-6:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Chiang can be reached on 571-272-7483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Suresh Memula/

Art Unit 2825
March 27, 2009

/Jack Chiang/
Supervisory Patent Examiner, Art Unit 2825